

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **JORDAN, et al.**

Examiner: SCHNEIDER, Rudolf

Art Unit: 1648

Application No.: **09/989,188**

Filed: **November 21, 2001**

Title: **PROCESS FOR SCREENING
CHEMICAL COMPOUNDS FOR
MODULATING THE INTERACTION
OF AN EVH1 DOMAIN AND A
PROCESS FOR DETECTING SAID
INTERACTION**

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 3. C.F.R. 1.705(b)-(d)

Sir:

Responsive to the Determination of Patent Term Adjustment posted on the Patent Application Information Retrieval System (PAIR) as of July 21, 2009, the issue date of U.S. Patent No. 7,563,582 and in light of the recent ruling in *Wyeth v. Dudas*, No. 07-1492, slip op. (D.D.C. Sept. 30, 2008) the Patentees submit this Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(b)-(d).

This application is not subject to a terminal disclaimer.

U.S. Patent No. 7,563,582 issued on July 21, 2009. This request is being submitted within two months of the issue date of U.S. Patent No. 7,563,582, and complies with the deadline specified in 37 C.F.R. 1.705(d). In addition, given the recent ruling in *Wyeth*, which was decided on September 30, 2008, the Patentee could not have raised this issue prior to payment of the issue fee. Thus Patentees contend this request is timely.

The data available on PAIR indicates that U.S. Patent No. 7,563,582 has been granted 510 days of Patent Term Adjustment. Patentees submit that, due to the recent *Wyeth* decision, the correct Patent Term Adjustment should be 1177 days. Patentee, therefore requests that U.S. Patent No. 7,563,582 be granted an additional 667 days of patent term.

Statement of the Facts and Explanation of Calculation

For purposes of this request and in keeping with the explanation provided in *Wyeth*, Patentees will refer to the "A delay" as examination delay under 37 C.F.R. 1.703(a). In the "A delay" the Patent Office delayed prosecution 670 days by issuing the first communication more than 14 months from filing or

January 21, 2003 to November 21, 2004 (the beginning of the period of "B delay"; with an additional 37 days of delay up to the mailing of the office action on December 28, 2004 not being counted due to overlap, see below). **Thus the total PTO "A delay" is 670 days.**

Delay due to applicant consists of 30 days in responding to the December 4, 2001 Notice to File Missing Parts on April 3, 2002; and an additional 17 days in responding to the December 28, 2004 restriction requirement on April 14, 2005. Applicant additionally delayed 175 days in responding to the June 22, 2005 office action on March 16, 2006; and an additional 61 days in responding to the May 26, 2006 final office action on October 26, 2006. Lastly, applicant delayed 59 days in responding to the August 20, 2007 office action on January 18, 2008. Thus total applicants delay is thus $30 + 17 + 175 + 61 + 59 = \underline{\underline{342 \text{ days}}}$.

The Patent Office delayed issuance of the patent by more than three years, and the period of "B delay" commences on November 21, 2004 (three year anniversary of the filing date) and ends with the filing of the RCE on March 30, 2007. (See 37 CFR 1.703(b)(1)). **Thus the period of "B delay" is 859 days by applicant's calculation.**

Therefore, the Patent Office was responsible for a total of $660 + 859 = 1,519$ days of delay and the applicant is responsible for 342 days of delay. Applicants believe the proper patent term adjustment under *Wyeth* is $1,519 - 342 = \underline{\underline{1,177 \text{ days}}}$.

In light of the foregoing, the Patentees respectfully request that an additional 667 days of Patent Term Adjustment be added to the patent term for Patent Office delay, resulting in a total Patent Term Adjustment of 1,177 days.

The Commissioner is authorized to charge the \$200.00 fee set forth in §1.18(e) required by 37 C.F.R. §1.705(b)(1) to Deposit Account No. 18-1982. The Commissioner is also authorized to charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,



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